



Penny L. Prater

OF COUNSEL

Penny Prater is an intellectual property lawyer with strengths in the areas of patent portfolio management, licensing, and dispute resolution. She has been legal representative on nearly 100 patents that were personally prosecuted in-house and collaborated with outside counsel on numerous others

CONTACT PENNY

Phone: +1 (248) 593-3309

Email: pprater@fishstewip.com



[linkedin.com/in/pennyprater/](https://www.linkedin.com/in/pennyprater/)

Overview

Penny is experienced in intellectual property matters, particularly in the energy and chemical and sectors, having worked for several major oil companies as an engineer, as well as a lawyer. She began her legal career as a patent examiner at the United States Patent and Trademark Office, in the area of drug delivery devices and bio-affecting drugs, and is also familiar with biotechnology and pharmaceutical issues.

Penny has negotiated dispute resolutions through use of cross-licenses and covenants not to sue and has effectively employed use of noninfringement and invalidity opinions to ensure freedom of operation. She understands the value of innovation and has developed patent portfolios that can be effectively monetized.

From 2000 to 2013, Penny was Senior Counsel with Chevron Corp. managing all areas of intellectual property, including freedom-to-operate studies and transactional work, as well as patent prosecution. In addition to preparing a variety of agreements and licenses, she collaborated regularly with outside counsel on noninfringement and invalidity opinions for special projects. These have included Chevron's Pascagoula Base Oil Project and Vacuum Residuum Slurry Hydrocracking Project. Penny also has been actively involved in foreign prosecution, including oppositions.

Between 1993 and 2000, Penny served as intellectual property counsel at Mobil Oil in Fairfax, Virginia. In that capacity, she prepared and negotiated cross-licenses with other major oil companies in the area of lubricant dewaxing technology. In addition, she prepared internal non-infringement opinions and invalidity studies, and patent applications in hydroprocessing technology and related areas. Penny was also a patent attorney for Exxon Corp. in Baton Rouge, Louisiana from 1990 to 1993, where she was engaged in patent prosecution in the areas of pillared clay and zeolite catalysts.

Practice Areas

- Patents
- Litigation and Dispute Resolution

Education

- George Washington University, LL.M., Patent and Trade Regulation (1991)
- Texas Tech University School of Law, J.D. (1996), M.B.A (1986)
- Texas Tech University, B.S. Chemical Engineering (1980)
- Lamar University, B.S. Chemistry and Biology, with honors (1977)

Memberships

Professional Associations/Memberships

- AIPLA
 - Licensing and Intellectual Property Portfolio Management Committee, Chair
 - Chemical Practice Chronicles, Energy Subcommittee
 - Organizer of panel on recent case law on licensee estoppel, AIPLA Fall 2012 meeting, Washington, DC
 - Panelist, "Impact of America Invents Act on corporations," AIPLA 2012 Mid-Winter Meeting, Las Vegas
 - Joint presenter, Techniques in management of large ip portfolios," AIPLA 2012 Spring Meeting, Austin
- Texas A&M Endowed Century Club
- American Technion Society
- Contra Costa County Library Commission
- Toastmaster's International

Admitted

- California (in-house counsel) (2005)
- Virginia (1998)
- Louisiana (1992)
- District of Columbia (1989)
- Texas (1987)
- United States Patent and Trademark Office (1991)

Achievements

Articles, Speaking Engagements, and Webinars

- During her tenure at Chevron, Penny served as editor of Chevron's internal IP publication On the Mark. She wrote and edited the following articles covering the latest issues in patent prosecution, trademarks, and licensing.
 - "Energy companies and non-practicing entities: An expanding litigation field," AIPLA Chemical Practice Chronicles, Winter 2014, Vol. 2, Issue 1, p.13
 - "AIA – how does it impact patent prosecution strategies?," On the Mark, a publication of Chevron
 - "Chinese anti-monopoly law update," On the Mark, a publication of Chevron